

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant(s) : Keith FitzPatrick  
Serial No. : 10/612,196  
For : SUBSTRATE FOR ENDLESS BELT FOR USE IN  
PAPERMAKING APPLICATIONS  
Filed : July 2, 2003  
Examiner : Andrew T. Piziali  
Art Unit : 1794  
Confirmation No. : 4118

745 Fifth Avenue  
New York, NY 10151

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

**Mail Stop AF**  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Claims 1-40 are pending in this application. Claims 1 and 32 are the sole independent claims. Claims 1-11, 13 and 32-40 remain rejected under 35 U.S.C. §102(b) or, in the alternative, under 35 U.S.C. §103(a) over U.S. Patent No. 5,753,485 to FitzPatrick ("FitzPatrick"). Claim 12 is rejected under 35 USC §103 over FitzPatrick in view of EP 0 960 975 to Davenport. Appellants respectfully request that the Panel consider the following arguments.

Claim 1 recites, *inter alia*:

A substrate...comprising: a plurality of individual preformed layers and a polymeric coating or impregnating material or rubber

material that is a part of each said individual preformed layers,  
wherein each individual preformed layer is a textile layer coated or  
impregnated with resin or the rubber material.

As amply explained in the prior responses and evidenced by, among other things, the Declaration of Francis L. Davenport, FitzPatrick fails to teach the above-recited limitation, and instead shows a single textile layer formed as a multilayer weave, and that structure is then coated. Despite this fact, the Office Action maintains the rejections using the substantially the same arguments as before the submitted Declaration. The evidence of record provides evidence of the more complete lamination of the claimed substrate. The Office Action presently alleges that the fact that the present invention results in nearly complete lamination is “unsupported argument.”

First, the 1974 case that the Office Action cites against the alleged “unsupported argument” is, *In re Pearson*, 494 F.2d 1399, 1405, which stands for the proposition that **attorney argument**, is not a substitute for evidence in the record: “Attorney's argument in a brief cannot take the place of evidence.” *Id.* An Affidavit or Declaration under 37 CFR 1.132 presents evidence, and must be considered and addressed. See MPEP 2145. Thus the Office Action errs in ignoring the facts presented therein.

The Declaration comprises the statements of fact of an expert in the field to which this application pertains. Without repeating the entirety of the Declaration, which speaks for itself, unaddressed evidence and **facts** adduced include, but are not limited to:

- The claims require a substrate that comprises a plurality of preformed layers and a polymeric coating, impregnating material or rubber material that is part of a respective layer, wherein each preformed layer is a textile layer or a textile layer coated or

impregnated with resin or the rubber material, and at least one layer of which contains a matrix of reinforcing components. Davenport Declaration ¶11.

- Figure 6 shows three layers of material (e.g. yarns) not woven together. *FitzPatrick*, col. 5, lines 38-49. Davenport Declaration ¶16. *After* those layers are brought into contact with each other, a **single** coating layer 50 is applied to this entire substrate of layers. *Id.* Davenport Declaration ¶16.
- FitzPatrick specifically discloses that the transverse continuous fine filaments 46 and longitudinal continuous fine filaments 48 are not interwoven with one another, but form a non-woven matrix. *Id.* Davenport Declaration ¶16. A polymeric resin coating 50 is provided on both sides of long nip press belt 44. *Id.* Davenport Declaration ¶16.
- To those of ordinary skill in the art, the single polymeric resin coating 50 in FitzPatrick is clearly different from the **distinct** resin layers of the instant invention *i.e.* a polymeric coating or impregnating material or rubber material that is part of **each** of said individual preformed layers. Davenport Declaration ¶16.
- Figure 5 shows a single textile layer formed of a multilayer weave. *FitzPatrick*, col. 5, lines 32-35. Davenport Declaration ¶18, 19.
- The claims, to the contrary, recite that “each individual preformed layer” is “coated or impregnated with resin or the rubber material” or that “a plurality of individual layers of preformed material [] are first coated with a polymer resin or rubber material individually and then combined to form a substrate of the belt.” Davenport Declaration ¶19.
- As each layer is accordingly coated or impregnated, the layers have fusible material which allows lamination between the layers to take place. Such a technique causes **a fairly complete lamination between adjacent layers, at nearly 100 percent coverage**, and

this is something that FitzPatrick's structure does not achieve. Davenport Declaration ¶¶12, 17, 19.

The Office Action's rebuttal is to simply say that Appellants have not shown that Fitzpatrick does not achieve 100 percent coverage, even though Appellants have proffered the testimony of an ordinarily skilled artisan that Fitzpatrick's laminate is deficient in just this respect and explained why.

Thus the Office Action's dismissal of the statements of fact throughout the Declaration as "unsupported argument," is in error. As MPEP 2145 states:

Office personnel should consider all rebuttal arguments and evidence presented by applicants. See, e.g., *Soni*, 54 F.3d at 750, 34 USPQ2d at 1687 (error not to consider evidence presented in the specification). C.f., *In re Alton*, 76 F.3d 1168, 37 USPQ2d 1578 (Fed. Cir. 1996) (error not to consider factual evidence submitted to counter a 35 U.S.C. 112 rejection); *In re Beattie*, 974 F.2d 1309, 1313, 24 USPQ2d 1040, 1042-43 (Fed. Cir. 1992) (Office personnel should consider declarations from those skilled in the art praising the claimed invention and opining that the art teaches away from the invention.)

Also, Appellants showed that as claimed, each individual preformed layer is a textile layer first coated/impregnated with resin or the rubber material -- *i.e.*, the individual layers of preformed components are first coated or impregnated with a polymer resin and then combined to form the substrate of a belt for papermaking machine applications. Davenport Declaration ¶9. The properties of the claimed laminated substrate and the requirements for its use in papermaking, such as dewatering as in a shoe press belt, sheet support and uniform pressure distribution in the nip, or ease of transfer of the sheet of paper from one position to another, may

be predetermined by application of these processes. Davenport Declaration ¶10. In other words, belts having specific predetermined properties (including different properties on the face and shoe sides or face and back sides of the belt) may be produced by varying the "layers" or structures used in forming the instant substrate. Davenport Declaration ¶10. In response, the Office Action alleges that these are "limitations from the specification not read into the claims." However, the proof was proffered to show that the clearly different structure of the claims imparts advantages that Fitzpatrick's structures cannot achieve. Hence the evidence shows yet another reason why the claimed substrate is not "identical to or only slightly different from" Fitzpatrick laminate, which is the only reason the Office Action has proffered in support of his rejection.

For at least the foregoing reasons, Appellant submits that claim 1 is patentably distinguished over FitzPatrick, and is therefore allowable. As independent claim 32 is somewhat similar to scope in claim 1, it is allowable for the same reasons. Appellant respectfully requests reconsideration and withdrawal of the rejections thereto. In view of the foregoing remarks, all of the claims in this application are patentable over the prior art, and an early and favorable consideration thereof is solicited.

Please charge any fees incurred by reason of this response and not paid herewith to Deposit Account No. 50-0320.

Respectfully submitted,  
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